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BAKER BOTTS L.L.P.  
2001 ROSS AVENUE  
SUITE 600  
DALLAS, TX 75201-2980

EXAMINER

HESS, DANIEL A

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/001,511

Applicant(s)

MORGANSTEIN, SANFORD J.

Examiner

Daniel A Hess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 47 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 and 48-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-46 and 48-57, drawn to an advanced electronic voting system, wherein voter records are stored and votes are received electronically, classified in class 235, subclass 386.

Group II. Claim 47, drawn to a layout for an absentee ballot, classified in class 235, subclass 487.

Group III. Claim 58, drawn to a scheme for leasing an electronic voting system under a particular pricing scheme, classified in class 705, subclass 400.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed pricing scheme of invention III can be applied to any alternate voting system that is designed to replace an existing paper ballot system, not just the voting system of invention I. The subcombination has separate utility such as for polls or surveys, that do not involve doing business with the election authorities to replace paper ballots..

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3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions operate in an entirely different manner. Invention I is an entirely electronic voting system while invention II is related to a paper ballot.

4. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions operate in an entirely different manner. Invention III is a scheme for leasing an electronic voting system while invention II is related to a paper ballot. The modes of operation are clearly different.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Brian W. Oaks on September 26, 2002 a provisional election was made without traverse to prosecute the invention of I, claims 1-46 and 48-57. Affirmation of this election must be made by applicant in replying to this Office action. Claims 47 and 58 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 35 rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. In particular, the tracking of votes to their source in an election is generally in contradiction to anonymity in voting laws.

### *Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1, 4-6, 8-11, 14-16, 18-27, 30-32, 34, 36-37, 40-46, 48-53, and 56-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Challener et al. (US 6,081,793).

Challener teaches an advanced electronic voting system having all of the elements and means as recited in claims 1, 4-6, 8-11, 14-16, 18-27 drawn to an apparatus and claims 30-32,

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34, 36-37, 40-46, 48-53, and 56-57 drawn to a method. For example Challenger teaches the following:

Re claims 1, 5, 8, 27, 31, 34, 48, 49 and 51: There is an electronic voting system (column 1, line 58). A variety of voter registration information is obtained (column 1, line 60- column 1, line 29) and stored on a smart card. This card acts as a key. This registration information is also passed to an authentication server 225 (column 3, lines 29-31; see figure 1a). The (implied) smart card generator generated an election key (smart card) storing information specific to each voter. The election process is discussed (column 7, line 35 to column 8, line 20). A reader interfaces with the election key (smart card) (column 7, line 42). As shown (column 7, line 35 to column 8, line 20) information is retrieved from the election key (smart card) such as pin number (column 7, line 47). Based on information retrieved from the key, identification may be determined, and the server selects a ballot id for the particular voter. The ballot id is associated with a particular precinct (column 3, lines 19-21). It is well-known in the art that different precincts have different questions, thus questions are customized for the voter. The system also displays questions and receives interactive voter selections (column 4, lines 15-43). An encoded ballot is created in a 'cryptolope' (column 8, lines 10-18). Further, a results server (column 10, line 59) tabulates all the votes.

Re claims 4, 30 and 50: In Challenger the pin number is stored on the smart card. There is a customized question based on the smart card, namely, 'What is my pin number?' -- the answer of which is different for each user.

Re claims 6, 32 and 52: The pin number is a digital signature (column 7, line 38 to column 8, line 10).

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Re claims 9 and 15: A voting record/ballot is linked to a particular computing device through an id: the 'public key of the journal server' (column 8, line 15).

Re claims 10, 16 and 36: This digital signature particular to the voter's precinct is the ballot id referred to re claim 1 above.

Re claims 11, 37 and 53: There is (column 4, line 39) a touch screen.

Re claims 14 and 40: As Challenger shows (column 7, lines 40-55) the pin number stored on the key and a voter-entered pin number are compared.

Re claim 17: A voter id (column 8, line 28) is present (i.e. as opposed to voter's name etc.).

Re claims 18, 41, 43 and 56: The determination of a properly filled-out ballot is understood and implicit in the term 'completes the ballot' (column 8, lines 9-12). The phrase 'encrypts the completed ballot' implies that the user must **complete** the ballot first.

Re claim 19: The system involves 'using the voter's PC' (column 8, line 12). It is understood in the art that a PDA is a scaled down version of a PC for most operations that aren't computationally or graphically out of range of a PDA.

Re claims 20-24, 42, 44 and 45: The Challenger invention includes 'all the functions associated with the tabulation of the votes' (column 10, lines 57-60). This would include auditing specific questions. Also, re 21-24 particularly, see (column 10, lines 50-68) the interactions of the results server and the journal server.

Re claim 25: The results server (column 10, lines 50-68) is a ballot reader that reads the vote.

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Re claims 26, 46 and 57: A keyboard 16 is available (column 4, lines 27-29). In keeping with election laws dictating the write-in option, it is implied that the system would have to make available this option.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challenger in view of Walter et al. (US 5,992,570). The teachings of Challenger have been discussed above.

Challenger fails to show that the voter enters a signature that is stored in electronic form.

As Walter shows (column 3, lines 64-67; figure 1, 26) a signature pad used for supermarket credit / debit credit validation obtains a digital signature.

In view of supermarket credit card systems, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known digital signature validation system taught by supermarket credit card system in the teachings of Challenger because this makes the voting process more secure by adding an additional security measure to fight fraud.



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13. Claims 7 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challenger.

Bar-coded cards, magnetic-stripe cards and smart cards are all art-recognized equivalent information bearing cards which represent alternate ways of storing machine readable information on a card.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the old and well-known magnetic stripe data storage means for the chip data storage means on the card of Challenger because magnetic stripe cards are cheaper to manufacture than chip cards.

14. Claims 3 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challenger in view of Drexler et al. (US 5,412,727). The teachings of Challenger have been discussed above.

Challenger fails to show verification of voters by biometric means.

Drexler shows (column 2, lines 29-51) verification of voters using biometric means.

In view of Drexler's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known biometric verification of voters as taught by Drexler in the teaching of Challenger because this added security measure can help to inhibit voter fraud and is not easily mimicked.

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15. Claims 12, 13, 38, 39, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challener in view of McClure et al. (US 6,250,548). The teachings of Challener have been discussed above.

The use of instructions, in text on the screen is implied, the minimal instructions being which instructions will cast a vote for which candidate. Any screen which shows such information can be called a help screen.

Challener fails to either language selection or text-to-speech capability.

McClure shows (see excerpt, 2<sup>nd</sup> page) language selection in electronic voting. McClure further shows (abstract, line 25) text-to-speech assistance of voters.

In view of McClure's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known language selection or text-to-speech assistance as taught by McClure in the help/information text or screens of Challener because this allows more universal access, toward the democratic goal of maximizing voter participation.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note that Challener teaches both paper and electronic balloting. The applicant is advised not to confuse these two embodiments. Killian et al. (EP 0 743 620 A2), Miyagawa (US 5,377,099), Peralto (5,878,399), Davis III et al. (5,583,329), and Graft, III (US 5,278,753) all show electronic voting and are applicable to the instant invention.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.


19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH

September 27, 2002

Daniel A Hess  
Examiner  
Art Unit 2876



MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800